

REMARKS

Claims 1-53 are pending in this application. By this Amendment, Applicants have amended claims 41, 47, 48 and 52 and cancelled claim 46. Reconsideration of the above-identified application in view of the foregoing amendments and the following remarks is respectfully requested.

Rejections Under 35 U.S.C. § 103:

Claims 1-4, 7-17, 50 and 53 were rejected under 35 U.S.C. §103 as being unpatentable over Gerszberg in view of Asai. Claims 18 and 19 were rejected under §103 as being unpatentable over Gerszberg and Asai in view of Nanba. Claims 5 was rejected under §103 as being unpatentable over Gerszberg and Asai in view of Hyakudai. Claim 6 was rejected under §103 as being unpatentable over Gerszberg and Asai in view of Munyan. Claims 20-24, 27-37, 41, 42, 46-49, 51 and 52 were rejected under §103 as being unpatentable over Gerszberg and Asai in view of Strietzel. Claim 44 was rejected under §103 as being unpatentable over Gerszberg, Asai and Strietzel in view of Masahiro. Claims 38 and 39 were rejected under §103 as being unpatentable over Gerszberg, Asai and Strietzel in view of Nanba. Claims 25 and 43 were rejected under §103 as being unpatentable over Gerszberg, Asai and Strietzel in view of Hyakudai. Claims 40 and 45 were rejected under §103 as being unpatentable over Gerszberg and Asai in view of Hamzy. Claim 26 was rejected under §103 as being unpatentable over Gerszberg, Asai and Strietzel in view of Munyan. Claims 1, 20, 41 and 50-53 are independent.

Claims 1, 20, 50, 51 and 53

Applicants' invention, as defined by claim 1, calls for: "displaying content on a bistable display; transmitting an indication of user inactivity; receiving an advertisement;

displaying the advertisement on the display; and removing power to the display, wherein the advertisement remains on the display after power has been removed.”

Gerszberg is directed to customer premises equipment that includes video telephones. In order to protect the displays on the video phones from damage due to burnout, a screen saver advertisement is employed that appears on the displays of the phones in response to user inactivity and then moves across the display. Additionally, the advertisement may initially be displayed at a low light level and then be gradually brightened until a maximum brightness is achieved prior to the advertisement being moved. (8/13-9/56)

Asai is directed to an electronic device with a display having a memory function onto which advertising information is displayed. The advertising information may be maintained on the display without requiring any power consumption. (Abstract)

Applicants respectfully submit that there is no motivation to modify Gerszberg to include the memory element display of Asai. In particular, as will be discussed in detail below, modifying Gerszberg to include the memory element display of Asai is inconsistent with the teachings of Gerszberg.

In Gerszberg, the video phones are, by design, not to be powered down, but rather, “are designed to be continuously used without being turned off.” (8/9-10) To prevent the video phone displays from burning out due to the same image being continuously displayed at the same location on the screen, Gerszberg teaches a screen saver in the form of an advertisement that moves across the display and, in addition, changes in brightness to peak the interest of potential users and passersby. In contrast, Asai teaches a display wherein power is shut off and the advertisement displayed thereon does not move nor does it change in brightness. The advertising screen saver function (i.e., animation of the advertisement during periods of

inactivity while power is on) is essential to Gerszberg – indeed, it is at the very core of Gerszberg’s teachings. Thus, Applicants respectfully submit that one of ordinary skill in the art at the time of their invention would not have been motivated to modify Gerszberg to include the memory element display of Asai and shut off power to the display because doing so would have vitiated the advertising screen saver function of Gerszberg, resulting in only the static display of an advertisement.

With respect to the Examiner’s comments that methods of saving power and prolonging the life of circuit components are known to one skilled in the art, clearly there are instances, however, where any benefits achieved by adopting such methods are outweighed by other factors relating to the structure and functionality of the particular device under consideration. For at least the reasons discussed above, that is also the case with the combination of Gerszberg and Asai. Again, Applicants submit that one of ordinary skill in the art would not have been motivated to modify Gerszberg to include the memory element of Asai because doing so would have frustrated the very purpose of Gerszberg, -- namely, the advertising screen saver function.

Accordingly, Applicants respectfully submit that claim 1 is not obvious over Gerszberg in view of Asai.

Claims 20, 50, 51 and 53 contain limitations similar to those found in claim 1 and are allowable for at least the same reasons.

Furthermore, with respect to claim 53, in addition to requiring “removing power to the display, wherein the advertisement remains on the display after power has been removed” claim 53 also requires “wherein power remains removed until user activity is detected”. Applicants respectfully submit that this feature further underscores the inconsistency in

combining Gerszberg and Asai. As discussed above, in Gerszberg, removing power until user activity is detected would disable the screen saver function since, in Gerszberg, an advertisement cannot move or change brightness without power. Moreover, although the Office Action contends that power to the display in Asai remains removed until user activity is detected, introducing such behavior into Gerszberg would not have enabled the animation of the advertisement because, in Gerszberg, the advertisement disappears from the screen upon the detection of user activity. Thus, with respect to claim 53, Applicants respectfully submit that one of ordinary skill in the art would not have been motivated to modify Gerszberg to include the memory element display of Asai for this additional reason.

Claims 41 and 52

Claim 41 has been amended to include the feature previously found in claim 46 of “receiving notice that the terminal has transferred the requested content to a second terminal having a bistable display; and in response to the notice, transmitting the advertisement linked to the requested content to the second terminal.” The Examiner contends that this feature is found in Asai on “page 6, sections [0114], [0120], and page 11, section [0186]”. Applicants respectfully disagree. Instead, the cited passages of Asai merely disclose a host apparatus transmitting information such as an advertisement from a transmission tower to portable telephones owned by users.

Accordingly, Applicants respectfully submit that claim 41, as amended, is allowable over the combination of Gerszberg, Asai and Striezel. Claim 52, as amended, contains limitations similar to those found in amended claim 41, and thus, is allowable for at least the same reasons.

Dependent Claims:

Dependent claim 49, which depends from claim 41, requires receiving information about other terminals that are in close proximity of the terminal; and transmitting advertisements to the other terminals. The Examiner contends that this feature is found in Asai on “page 6, sections [0114], [0120], and page 11, section, section [0186]”. Applicants respectfully disagree. Instead, as noted above, the cited passages of Asai merely disclose a host apparatus transmitting information such as an advertisement from a transmission tower to portable telephones owned by users.

Applicants do not believe it necessary at this time to further address the rejections of the dependent claims as Applicants believe that the foregoing arguments and amendments place the independent claims in condition for allowance. Applicants, however, reserve the right to address those rejections in the future should such a response be deemed necessary and appropriate.

For the above-stated reasons, this application is respectfully asserted to be in condition for allowance, and an early and favorable examination on the merits is respectfully requested.

AUTHORIZATION

The Commissioner is hereby authorized to charge any additional fees which may be required by this response, or credit any overpayment to Deposit Account No. 13-4500, Order No. 4208-4014. A DUPLICATE COPY OF THIS PAPER IS ATTACHED.

In the event that an extension of time is required, or which may be required in addition to that requested in a petition for an extension of time, the Commissioner is requested to grant a petition for that extension of time which is required to make this response timely and is hereby authorized to charge any fee for such an extension of time or credit any overpayment for an extension of time to Deposit Account No. 13-4500, Order No. 4208-4014. A DUPLICATE COPY OF THIS PAPER IS ATTACHED.

Respectfully submitted,
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